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| 10/552,121 | 10/05/2005 | Tamas Hume | 1376-053035 | 4077 |
| 28289 7590 09/30/2008 THE WEBB LAW FIRM, P.C. 700 KOPPERS BUILDING 436 SEVENTH AVENUE PITTSBURGH, PA 15219 | | | | |
| EXAMINER | | | | |
| YAN, REN LUO | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,121

Applicant(s)

HUME ET AL.

Examiner

Ren L. Yan

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 9-2-2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6, 9-12, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hutchinson et al(5,167,739).

With respect to claim 1, Hutchinson et al teach a method for forming a document set as claimed, said document set formed from rectangular sheets of the same size and including an envelope sheet 10, 13 and at least one insert sheet 12, the method including the steps of: printing said envelope sheet with envelope information, said envelope information including a unique code identifier 69 to identify the envelope sheet; printing each of said at least one insert sheets with insert information, said insert information including a further unique code identifier 69 to identify each of the at least one insert sheet, and collating said envelope sheet and at least one insert sheet to form said document set 78. The code identifiers 69 are common to the envelope and insert sheets 10, 12 and 13 that are to be assembled into a final multi page mailer 78. However, such code identifiers are unique to the other code identifier in different assembled mailers. Therefore, it is believed that this limitation is met. See Figs. 1-10 and column 5, line 43 through column 6, line 20 in Hutchinson et al for details.

Regarding claim 2, Hutchinson et al further teach the step of verifying said document set by reading each of said code identifier and said further unique code identifier and performing a

self-referencing integrity check at scanning/verification stage 74.

Regarding claim 6, Hutchinson et al teach said unique code identifier identifies whether a printed sheet is an envelope sheet such as 10 or 13.

Regarding claim 9, Hutchinson et al teach said unique code identifiers are barcodes.

Regarding claim 10, Hutchinson et al the steps of printing the envelope sheet, printing the at least one insert sheet and collating the envelope sheet and at least one insert sheet are accomplished using a common printer 67.

Regarding claim 11, Hutchinson et al teach wherein said envelope information is printed on one side of said envelope sheet 10.

Regarding claim 12, Hutchinson et al teach the method for forming a document set as discussed above and further including the step of applying an adhesive layer to at least one side of said envelope sheet in a predetermined pattern, said pattern arranged to provide adhesive means for an envelope formed from said envelope sheet when said envelope from said envelope sheet is re-used.

Regarding claim 15, Hutchinson et al teach an apparatus for forming a document set, said document set formed from rectangular sheets of the same size and including an envelope sheet and at least one insert sheet 10, 12 and 13, said apparatus including: a printer 67 for printing said envelope sheet with envelope information, said envelope information including a unique code identifier 69 to identify the envelope sheet and furthermore for printing each of said at least one insert sheets with insert information, said insert information including a further unique code identifier 69 to identify each of said at least one insert sheet, and a collator for collating said envelope sheet and at least one insert sheet to form said document set 78. The code identifier is

common to the sheets 10, 12 and 13 that are to be assembled into a final multi page mailer 78 and therefore, these code identifiers are unique to the other mailers. See Figs. 1-10 and column 5, line 43 through column 6, line 20 in Hutchinson et al for details.

Regarding claim 16, Hutchinson et al further teach the use of a scanner for scanning each said unique code identifier and said further unique code identifier; and a data processor to process said unique code identifier and said further unique code identifier and perform a self-referencing integrity check, thereby verifying the document set at 74.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5, 7, 8, 13, 14 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutchinson et al(5,167,739) in view of Fig. 1 Applicant's Admitted Prior Art(hereafter AAPA).

With respect to claims 3-5 and 17-19, Hutchinson et al teach all that is claimed but is silent about out sorting any document set using a sorter that fails said integrity check, rescheduling the printing of said document set that failed said integrity check and wherein rescheduling is performed online.

AAPA teaches a method and apparatus for forming a document set using a code scanner to read the code identifier and performing a self-referencing integrity check and the steps of out sorting any document set that fails said integrity check using a sorer, rescheduling the printing of

said document set that failed said integrity check and wherein rescheduling is performed online. See Fig. 1 and pages 1 and 2 of the present specification for example.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method and apparatus of Hutchinson et al with the capability of out sorting the document set that fails the integrity check and rescheduling the printing of the document set online as taught by AAPA in order to effectively replace the missing document set.

Regarding claim 7, Hutchinson et al teach all that is claimed except for the unique code identifier to include the number of at least one insert sheets associated with said envelope sheet to form said document set. AAPA teaches in a paragraph bridging pages 1 and 2 of the present specification the unique code identifier printed on the sheet that includes a number of sheets to be inserted into envelopes. It would have been obvious to one of ordinary skill in the art to provide the number of sheets to be included in the envelope of the document set in order for the scanner to verify the correct number of sheets to be placed in the envelope in the document set.

With respect to claim 8, since the combination of Hutchinson et al and AAPA teaches to form a personalized a document set with personalized information pertaining to the individual, it would have been obvious to those skilled in the art at the time of the invention to include in the unique code identifier information relating to customer information, content information and distribution information associated with said document set to ensure that the assembled document set will be mailed to the right person.

Regarding claims 13 and 20, Hutchinson et al teach all that is claimed except for folding the insert sheet to form a folded sheet set to be inserted inside an envelope. AAPA teaches the conventional way of folding the insert sheet into a folded sheet set to be inserted inside an

envelope. It would have been obvious to those having ordinary skill in the art at the time of the invention to provide the document set with an insert sheet being folded and then wrapped by an envelope as a simple substitution of one known way of assembling a document set with another to achieve the same expected result.

Regarding claims 14 and 21, the combination of Hutchinson et al and AAPA teach a bulk mail out item resulting from the method as claimed in claims 13 and 20.

Applicant's arguments filed 6-26-2008 have been fully considered but they are not persuasive.

Applicant argued the Hutchinson patent does not teach or suggest use of a single envelope sheet to form an envelope about the insert sheets. This argument is not persuasive because the pending independent claims 1, 12 and 15 are all written in open terminology and thus they are not limited to the use of a single envelope sheet to form an envelope about the insert sheets as argued. Additionally, the use of the open terminology in the claims does not exclude the extra elements the Hutchinson patent may or may not teach.

Applicant also argued that the Hutchinson parent does not teach or suggest the use of unique code identifiers that uniquely identify each sheet of the document set and thus fails to teach the self-referencing checks. This argument is also not persuasive. As a matter of fact, the unique code identifier 69 printed on each sheet 10, 12 and 13 in the document set is to facilitate self-referencing checks such that each of the sheets belonging in the same document set would be recognized and assembled together and not to be mixed with the sheets in other document sets. As pointed out in the forgoing rejections, the common code identifiers 69 printed on each of the sheets in a document set are unique code identifiers different from the unique code

identifiers of the other document sets. The unique code identifier and the further unique code identifier as recited in the amendments to the claims filed on 6-26-2008 have not structurally differentiated themselves from the unique code identifiers 69 taught by Hutchinson. Accordingly, the rejection over the teaching of Hutchinson is maintained.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ren L. Yan whose telephone number is 571-272-2173. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ren L Yan/
Primary Examiner, Art Unit 2854
September 27, 2008